

Application No.: 10/042,473

REMARKS

The Office Action of September 9, 2004 has been carefully considered. As noted in the prior Response submitted July 9, 2004, Applicants request that the Examiner provide the basis for rejections of dependent claims under 35 U.S.C. §102, as the prior action did not have a complete rejection, and thereby Applicants were precluded from an opportunity to respond to such rejections. While the present Office Action (September 9, 2004) includes some details of rejections for the dependent claims, not all of the rejected dependent claims are addressed and no citation to reference numerals or sections of the '773 patent are provided. Furthermore, this is Applicants' first opportunity to respond to such rejections. Conversely, the present action has been indicated as a Final Rejection, in spite of the fact that an output was inherently referred to with respect to claims 12 and 14. Hence, Applicants respectfully request that the Examiner withdraw the holding of finality and to confirm entry of the claim amendments in a subsequent action.

Entry of the amendments presented herein, and reconsideration of this application, are respectfully requested. Applicants submit that the proposed amendment places the sole independent claim in condition for allowance. Such an amendment was not earlier submitted as Applicants believed that the previously entered amendments were adequate to patentably distinguish claim 1 from the asserted references. The present amendment is supported in the specification at pg. 3, lines 18-19; pg. 5, lines 30-32; pg 6, lines 1-2; pg. 7, lines 18 & 30-33 (non-pressurized liquid reservoir) and at pg. 7, lines 1-10 and pg. 2, line 22-23 & pg. 7, lines 15-16 (controllable delivery system, where a rate of flow through the controllable delivery system is adjusted). Accordingly, no new matter is presented by the proposed amendments. Furthermore, Applicants respectfully urge that the claim amendments place the claims in condition for allowance, or at least in suitable condition for appeal and are thereby appropriate for entry.

Claim 1 has been amended to add the limitation of a non-pressurized reservoir and to replace the recited "outlet" with "a delivery system to direct the liquid containing dissolved ozone to the point of use, where a rate of flow through the controllable delivery system is adjusted by the user." Support for these amendments is found in the as-filed application as noted above. Claims 12, 15 and 23 have been amended for purposes of clarification and grammatical consistency.

Application No.: 10/042,473

It is respectfully noted that claim 25 has been canceled without prejudice or disclaimer to the subject matter contained therein. Accordingly, the rejections under 35 USC §112, first and second paragraph, are believed to be overcome by cancellation.

With respect to the nature of the claimed invention, Applicants suggest that the function is to output from a reservoir to the point-of-use, a liquid containing dissolved ozone at a desired, manually variable, flow rate.

Turning now to the office action, claims 1 – 7 and 10 – 32 were rejected under 35 USC §102 as being anticipated by Burris 5,213,773 ('773), cited by Applicants. Claim 8 was rejected under 35 USC §103 as being unpatentable over '773 in view of Burris 5,422,043 ('043) or Burris 5,858,283 ('283), both of which were cited by Applicants.

Turning now to the rejection of claims 1 – 7 and 10 – 32 under 35 USC §102 as being anticipated by '773, as noted above, Applicants have proposed amendment of claim 1 to add the further limitations of a "non-pressurized liquid reservoir," and of "a controllable delivery system to direct the liquid containing dissolved ozone to the point of use, where a rate of flow through the controllable delivery system is adjusted by the user." Applicants respectfully contend that these limitations are not taught or suggested by '773. Furthermore, while '773 discloses liquid that may contain dissolved ozone for a limited period of time, it does not teach an apparatus for dispensing liquid containing dissolved ozone, nor the ability to control the flow rate thereof. In view of the amendment to claim 1, Applicants respectfully urge that claim 1 cannot be anticipated by '773, and is therefore in condition for allowance. Insofar as claims 2 - 7 and 10 - 32, are concerned, these claims all depend from now presumably allowable amended claim 1 and are also believed to be in allowable condition for the reasons hereinbefore discussed with regard to claim 1.

With respect to dependent claims 2 – 7 and 10 – 32, these dependent claims were also rejected as being anticipated by Burris '773, yet the Examiner has again failed to identify specific teachings within '773 to support the rejections. While the remarks urge the presence of various claimed features, absent references, Applicants are left to wonder what has been relied upon as the basis for the rejection. Accordingly, *prima facie* anticipation of several of the dependent claims has not been established and any holding of finality of the rejection is premature.

Application No.: 10/042,473

For example, the Examiner has now stated that '773 teaches that excess ozonated liquid is recirculated (e.g., claims 4, 13, 14). However, Applicants review of the '773 patent does not indicate any use of the term "recirculated" or of excess liquid. Absent such teaching, the claims cannot be anticipated, and Applicants respectfully request an indication of the allowance of claims 4-7, 13 and 14.

With respect to claim 10, no teaching of the generation of more ozone than can be dissolved is found in '773. Accordingly, the limitations of claim 10 are not anticipated by '773. A similar limitation is found in claim 11, and again absent a reference to a particular teaching of the dissolved ozone concentration being determined by the solubility of ozone in the liquid, no rejection can stand.

Claim 12 further defines the manner in which the flow of ozonated liquid is controlled through a dispensing tip – use of a valve to control flow. Here again, the Examiner has not indicated where such a limitation is found in '773. Thus, the claim cannot be anticipated and must be indicated as allowable or a suitable rejection set forth.

In claims 15 – 17, specific limitations are directed to a pulsation of the liquid and Applicants respectfully urge that no such limitation has been identified in support of the rejection of such claims. Moreover, because the term "pulsate" or "pulsation" is not found in '773, the patent cannot support a rejection under §102. Accordingly, claims 15 – 17 are presently believed to be in condition for allowance, and an indication thereof is respectfully requested in a subsequent office action.

With respect to a rejection of claim 23, the Examiner apparently relies on the teaching in '773 of a reservoir 13 (Figures and col. 3 cited), but Applicants are once again unable to identify where in the '773 patent, the term "removable" is employed to characterize the reservoir. Moreover, Figures 3 – 6 do not even include a reservoir 13. Accordingly, Applicants respectfully submit that the rejection is, at best, incomplete and must fail as the limitation of a removable reservoir is not disclosed in the '773 patent. In the event that the various rejections of dependent claims addressed above are maintained in a subsequent Office Action, particularly with respect to the dependent claims 2 – 8, 10 – 24 and 26 – 32, Applicants respectfully request that the Examiner specifically set forth the teachings relied upon to support each claim rejection, and that Applicants be provided an opportunity to respond to such rejections in detail or to further amend claims to overcome a proper rejection.

Application No.: 10/042,473

Turning next to the rejection of claim 8 under 35 USC §103 as being unpatentable over '773 in view of '043 or '283, the disclosures of the cited patents and the distinctions between claim 8, which also depends from claim 1, may be briefly described as follows. Additionally, the distinctions relative to claim 1 are set forth above and Applicants incorporate those arguments in traversal of the 35 USC §103 rejection as well.

The Examiner fails to indicate, other than an apparent reliance on the claims of the instant application as a "recipe" for the piecemeal combination of elements, what teaching or suggestion is relied upon for the motivation to make the proposed combination and modification of the '773 teachings. Instead, the Examiner has misconstrued Applicants' prior arguments as requiring that the secondary references must be bodily incorporated or expressly suggested in the references. The intent of the prior comments by Applicants was to point out that the Examiner has failed to indicate where any of the references suggest the proposed combination or modification. Absent a teaching or suggestion of the problem addressed or advantages achieved by the limitation, *prima facie* obviousness is not established.

Considering, *in arguendo*, the combination of '773 in view of '043 or alternatively '283, neither '043 or '283 teach the limitations of amended claim 1 - where the device includes a non-pressurized reservoir and a controllable delivery system (as noted above). Hence, even if the arguable, alternative combinations set forth by the Examiner were deemed to establish *prima facie* obviousness, no teaching is found relative to the additional limitation of claim 1, and therefore dependent claim 8. Thus, dependent claim 8 is respectfully asserted to be patentably distinguishable over the combination.

Here again, Applicants respectfully urge that the rejection is either improper or has been overcome by the amendment to claim 1, and anticipate the withdrawal of the rejection and an indication that claim 8 is allowable in a subsequent communication from the Examiner.

In view of the foregoing remarks and amendments, reconsideration of this application and allowance thereof are earnestly solicited. In the event that additional fees are required as a result of this response, including fees for extensions of time, such fees should be charged to USPTO Deposit Account No. 50-2737 for Basch & Nickerson LLP.

Application No.: 10/042,473

In the event the Examiner considers personal contact advantageous to the timely disposition of this case, the Examiner is hereby authorized to call Applicant's attorney, Duane C. Basch, at Telephone Number (585) 899-3970, Penfield, New York.

Respectfully submitted,



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